



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,161	10/31/2003	Ben-Ren Chen	50108-078	9108

7590 02/08/2006
McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

DESIR, PIERRE LOUIS

ART UNIT	PAPER NUMBER
----------	--------------

2681

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,161

Applicant(s)

CHEN ET AL.

Examiner

Pierre-Louis Desir

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/09/2005 have been fully considered but they are not persuasive.

Applicant argues that the office action statement that the Kalmanek announcement “be customized, perhaps based on the originating number, dialed number, time-of-day” has not been found in Kalmanek. Applicant further agrees that Kalmanek does not disclose or suggest that the audio presentation be related to the time of day.

Examiner refers applicant to col. 67, lines 55-57 of the reference, wherein Kalmanek discloses, “announcement to be customized, perhaps based on the originating number, dialed number, time-of-day.” Therefore, Kalmanek discloses the audio presentation may be related to time-of-day.

Applicant further argues that Kalmanek does not disclose that the subscriber identified criteria for determining the audio presentation is related to the identity of, or geographical location of, the caller.

Examiner respectfully disagrees. Kalmanek discloses that the announcement may be customized based on the originating number (i.e., identity of the caller and the location of the caller comparing to, for example, a foreign network where called telephone might be located) (see col. 67, lines 55-57). Kalmanek further discloses that the prestored ring back signal can be for example, a signal that is indicative of the network associated with the called party rather than a signal that otherwise would be originated by that network. For example, a ring back signal indicative of a foreign network can be stored at the originating telephone. In this case, when a

Art Unit: 2681

ring back message is received at the originating TIU indicating that telephone of the called party is ringing, for example, the prestored ring back signal indicative of the foreign network can be sent to the calling party from the originating TIU (col. 20, lines 1-12). Therefore, one skilled in the art would unhesitatingly conceptualize that since the prestored ring back is stored at the originating telephone and based on the originating number, and is not originated from the foreign network (called party network), the prestored ring back is based on the identity of the caller, and the geographical of the caller as compared to the location of the called party.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7-9, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang et al. (Jiang), Pub. No. US2004/0120494, in view of Kalmanek, Jr. et al. (Kalmanek), U.S. Patent No. 6574335.

Regarding claims 7-9, Jiang discloses in a telephone communications system comprising a plurality of mobile telephone stations (i.e. calling party 108, and called party 110) (see fig. 1, page 2, paragraph 21), a plurality of base stations interfaced for wireless communications with the plurality of mobile stations (as known in the art, base stations are typically used two-way radios such as mobile phone and portable phones). When one talks on such a mobile phone, one is talking to a nearby base station. From that base station the phone call is connected into the

regular land-line phone system by the mobile phone network; thus the disclosure of the plurality of base stations is inherent), and a mobile switching center connected in a mobile telephone network to the base stations for controlling wireless telephone communications (see fig. 1, page 2, paragraph 21), a method for processing an incoming call from a caller for a mobile telephone station subscriber in response to receipt of the incoming call at a home or gateway mobile switching center for the subscriber (see page 2, paragraph 21), the method comprising the steps of: determining whether the called mobile station subscriber subscribes to an alternative ringback feature (i.e. the MSC contacts the HLR, which performs a database look-up for user and returns a service flag which provides information including whether the user has subscribed to a ringtone feature) (see fig. 2, page 3, paragraph 30); establishing a call path to the caller between the subscriber mobile switching center and an audio content server (inherent) if the mobile station subscriber subscribes to the alternative ringback feature (i.e. the IP receives the message from MSC and generates the custom ringtone. This ringtone will be transmitted from EP to MSC from where it can be routed back to caller) (see fig. 2, page 3, paragraph 34); transmitting a pre-selected audio presentation from the audio content server to the caller in lieu of audible ringback signals (see page 1, paragraph 7, page 2, paragraph 26); identifying the call location of the called subscriber station (i.e. to initiate the process, the user at one mobile station dials the telephone number for a subscriber. Accordingly, a message is sent to MSC, which is MSC local to the user's location, which will route the call to the called subscriber MSC) (see page 3, paragraph 29); extending a call leg from the subscriber mobile switching center to the subscriber station or a subscriber call forwarding station (i.e. transmission from EP to MSC from where ringtone can be routed back to caller) (see fig. 2, page 3, paragraph 34); in response to an answer of the call

Art Unit: 2681

by the subscriber station or a subscriber call forwarding station, disconnecting the audio content server from the caller and connecting the caller to the call leg (i.e. When the connection with called party is complete, the custom ringtone would typically be disconnected. The network would then connect parties so that the communication could commence. Also, it should be noted that the audio clips are stored in an inherent audio/sound server) (see fig. 2, page 3, paragraph 36).

Although Jiang discloses a method as described above (and giving the fact that subject matter in the Jiang reference that is not supported by the provisional application is not entitled to the benefit of the earlier date as related to the provisional application's date), Jiang does not specifically disclose a method wherein the step of transmitting comprises accessing on of a plurality of stored audio presentations on the basis of subscriber identified criteria, wherein the subscriber identified criteria is related to the identity of the caller, nor does he disclose the subscriber identified criteria is related to the geographical location of the caller (**as related to claim 8**). And, Jiang does not specifically disclose the subscriber identified criteria is related to the time of day of the incoming call (**as related to claim 9**).

However, Kalmanek discloses that the announcement may be customized based on the originating number (i.e., identity of the caller and the location of the caller comparing to, for example, a foreign network where called telephone might be located) (see col. 67, lines 55-57). Kalmanek further discloses that the prestored ring back signal can be for example, a signal that is indicative of the network associated with the called party rather than a signal that otherwise would be originated by that network. For example, a ring back signal indicative of a foreign network can be stored at the originating telephone. In this case, when a ring back message is

Art Unit: 2681

received at the originating TIU indicating that telephone of the called party is ringing, for example, the prestored ring back signal indicative of the foreign network can be sent to the calling party from the originating TIU (col. 20, lines 1-12). Therefore, one skilled in the art would unhesitatingly conceptualize that since the prestored ring back is stored at the originating telephone and based on the originating number, and is not originated from the foreign network (called party network), the prestored ring back is based on the identity of the caller, and the geographical of the caller as compared to the location of the called party. Kalmanek additionally discloses a method wherein some services require the announcement to be customized, perhaps based on the originating number, dialed number, time-of-day (see col. 67, lines 55-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the characteristics of Kalmanek's method with the method as described by Jiang to arrive at the claimed invention. A motivation for doing so would have been to provide a method wherein the ringback signal is dependent of the particular remote network where the remote user is located.

Regarding claim 15-17, Jiang discloses a mobile telephone communication system comprising a plurality of base stations interfaced for wireless communications with a plurality of mobile stations (i.e. calling party 108, and called party 110. Also, as known in the art, base stations are typically used two-way radios such as mobile phone and portable phones. When one talks on such a mobile phone, one is talking to a nearby base station. From that base station the phone call is connected into the regular land-line phone system by the mobile phone network; thus the disclosure of the plurality of base stations is inherent) (see fig. 1, page 2, paragraph 21; a mobile switching center connected in a mobile telephone network to the base stations for

Art Unit: 2681

controlling wireless telephone communications (see fig. 1, page 2, paragraph 21); a home location register coupled to the mobile telephone network and having stored therein identification of mobile stations subscribed to the alternative ringback feature (i.e. as disclosed earlier the MSC contacts HLR, which performs a database look-up for user and returns a service flag to the MSC. The service flag provides a number of pieces of. As known in the art the HLR is the element where all of the subscribers' data is stored. It contains a database of all an operator's subscribers keyed . Data stored includes: the subscriber's identity number, the subscriber's phone number, and current location of subscriber) (see page 3, paragraph 30); an audio content server coupled to the mobile telephone network (inherent because ringback tone are stored in a server); wherein in response to receipt of an incoming call at the mobile switching center, determination is made whether the called mobile station subscriber subscribes to an alternative ringback feature by a query to the home location register (i.e. the MSC contacts the HLR, which performs a database look-up for user and returns a service flag which provides information including whether the user has subscribed to a ringtone feature) (see fig. 2, page 3, paragraph 30), a call path is established to the caller between the subscriber mobile switching center and an audio content server if the mobile station subscriber subscribes to the alternative ringback feature (i.e. the IP receives the message from MSC and generates the custom ringtone. This ringtone will be transmitted from EP to MSC from where it can be routed back to caller) (see fig. 2, page 3, paragraph 34); a pre-selected audio presentation is transmitted from the audio content server to the caller in lieu of audible ringback signals (see page 1, paragraph 7, page 2, paragraph 26); the call location of the called subscriber station is identified (i.e. along with the contact of the HLR, to initiate the process, the user at one mobile station dials the telephone

number for a subscriber. Accordingly, a message is sent to MSC, which is MSC local to the user's location, which will route the call to the called subscriber MSC) (see page 3, paragraphs 29-30); a call leg is extended from the subscriber mobile switching center to the subscriber station or a subscriber call forwarding station (i.e. transmission from EP to MSC from where ringtone can be routed back to caller) (see fig. 2, page 3, paragraph 34); and in response to an answer of the call by the subscriber station or a subscriber call forwarding station, the audio content server is disconnected from the caller and the caller is connected to the call leg (i.e. When the connection with called party is complete, the custom ringtone would typically be disconnected. The network would then connect parties so that the communication could commence. Also, it should be noted that the audio clips are stored in an inherent audio/sound server) (see fig. 2, page 3, and paragraph 36).

Although Jiang discloses a system as described (and giving the fact that subject matter in the Jiang reference that is not supported by the provisional application is not entitled to the benefit of the earlier date as related to the provisional application's date), Jiang does not specifically disclose a system wherein subscriber identified criteria associating a plurality of stored presentations with a subscriber to the alternative ringback feature, wherein the subscriber identified criteria is related to the identity of the caller, the geographical location of the caller (as related to claim 16), to the time of day of the incoming call (as related to claim 17).

However, Kalmanek discloses that the announcement may be customized based on the originating number (i.e., identity of the caller and the location of the caller comparing to, for example, a foreign network where called telephone might be located) (see col. 67, lines 55-57). Kalmanek further discloses that the prestored ring back signal can be for example, a signal that is

Art Unit: 2681

indicative of the network associated with the called party rather than a signal that otherwise would be originated by that network. For example, a ring back signal indicative of a foreign network can be stored at the originating telephone. In this case, when a ring back message is received at the originating TIU indicating that telephone of the called party is ringing, for example, the prestored ring back signal indicative of the foreign network can be sent to the calling party from the originating TIU (col. 20, lines 1-12). Therefore, one skilled in the art would unhesitatingly conceptualize that since the prestored ring back is stored at the originating telephone and based on the originating number, and is not originated from the foreign network (called party network), the prestored ring back is based on the identity of the caller, and the geographical of the caller as compared to the location of the called party. Kalmanek additionally discloses a method wherein some services require the announcement to be customized, perhaps based on the originating number, dialed number, time-of-day (see col. 67, lines 55-57). Kalmanek additionally discloses a method wherein some services require the announcement to be customized, perhaps based on the originating number, dialed number, time-of-day (see col. 67, lines 55-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the characteristics of Kalmanek's system with the system as described by Jiang to arrive at the claimed invention. A motivation for doing so would have been to provide a method wherein the ringback signal is dependent of the particular remote network where the remote user is located.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is (571) 272-779. The examiner can normally be reached on Monday-Friday 8:00AM- 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre-Louis Desir
AU 2681
02/04/2006



JOSEPH FEILD
SUPERVISORY PATENT EXAMINER